

**REMARKS**

Claims 1-4, 6-8, 11-14, 17-23, and 25-31 are pending in this application. Claims 1, 6, 17-19, 26, 27, and 31 are independent. In light of the remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

**Official Action**

In the outstanding Official Action, the Examiner rejected claim 1-4, 6-8, 11-14, 17-23, 25-27, and 31 under 35 U.S.C. § 103(a) as being unpatentable over *Garfinkle* (USP 6,133,985) in view of *Stein et al.* (USP 5,826,241); and rejected claims 2-3, 7, 13-14, and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over *Garfinkle* in view of *Parulski* (EP 860980). Applicants respectfully traverse these rejections.

**Claim Rejections - 35 U.S.C. § 103**

In support of the Examiner's rejection of claim 1, the Examiner admits that *Garfinkle* fails to teach or suggest a user address setting means for enabling the service user to set their electronic mail address thereof wherein the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message. The Examiner relies on the teachings of *Stein* to cure the deficiencies of *Garfinkle*. Specifically, the Examiner asserts that *Stein et al.* discloses when the buyer prepares a transfer-query message the

transaction-identifier is placed in the subject of the transfer-query message and the e-mail address to which the buyer's transfer-response message should be sent (e.g., "response at card.com") is placed in the sender's address of the transfer-query message (see col. 8, lines 19-36). Applicants respectfully disagree with the Examiner's characterization of this reference.

It is respectfully submitted that the disclosure set forth in *Stein et al.* is directed to a computerized system for making payments and authenticating transactions over the Internet. The payment system enables a first Internet user to make a payment to a second Internet user for the purchase of an information product deliverable over the Internet. When the second user sends the information product to the first user over the Internet, the second user also makes a request over the Internet to a front end portion of the payment system requesting payment from the first user. The front end portion of the payment system queries the first user over the Internet whether to proceed with payment to the second user. If the first user replies affirmatively, a charge to the first user is processed. However, if the first user replies negatively, the first user is not charged for the information product.

Specifically, in cols. 7-8 of the *Stein et al.* patent, the front end program 90 asks the buyer whether the buyer wishes to authorize payment for the transaction to the seller. The front end

program sends a transfer query message to the buyer. Using the information contained in the transfer request message from the seller, specifically, the buyer's card number and the seller's card number, the front end program looks up the buyer's name and the seller's name. After sending the transfer query message, the front end program 90 waits for a response from the buyer 20. The buyer may respond by sending a transfer response message to the front end computer via the Internet as shown in Fig. 8. In the transfer query message 140, the transaction identifier 142 is placed in the subject of the transfer query message and the e-mail address to which the buyer's transfer response message should be sent is placed in the sender's address of the transfer query message 140.

In other words, in order to ensure that the proper return address, or sender's address, is placed in the sender's address portion of the e-mail, the front end program 90 inserts the address to which a response should be sent. It is respectfully submitted that this transaction does not teach or suggest the user address setting means of the present invention as it is not the service user that sets the return address, but the front end program.

It is respectfully submitted that the present invention as set forth in claim 1 recites, *inter alia*, an application server used in a network photograph service system comprising user address setting means for enabling the service user to set their electronic mail

address thereof wherein the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message. It is respectfully submitted that *Stein et al.* does not teach enabling the service user to set the address of the sender of the mail message. As such, it is respectfully submitted that *Stein et al.* does not cure the deficiencies of the teachings of *Garfinkle*.

It is further respectfully submitted that claims dependent on claim 1 are allowable at least based upon their dependency on claim 1. It is further respectfully submitted that claims 6, 17-19, 26, 27, and 31 contain elements similar to those discussed above with regard to claim 1 and, thus, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 1.

#### Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

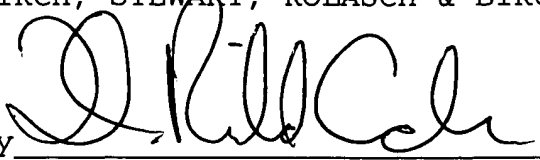
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any


Appl. No. 09/246,695

overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
D. Richard Anderson, #40,439

  
DRA/CMV/jdm  
2091-0186P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

(Rev. 09/30/03)